

REMARKS

Applicants have carefully studied the outstanding Office Action. The present amendment is intended to place the application in condition for allowance and is believed to overcome all of the objections and rejections made by the Examiner. Favorable reconsideration and allowance of the application are respectfully requested.

Applicants have canceled claims **60, 68, 77 and 84** and amended claims **1, 13, 15, 19, 29, 32 – 34, 38, 42 – 44, 48, 52 – 54, 59, 67, 76 and 83** to more properly claim the present invention. No new matter has been added. Claims **1 – 36, 38 – 57, 59, 61 – 67, 69 – 76, 78 – 83 and 85 – 89** are presented for examination.

In the Office Action Summary, the claims **76 – 89** are omitted from the list of rejected claims.

In paragraphs 1 and 2 of the Office Action, the Examiner has rejected claims **1, 8, 9, 11 – 16, 19, 26, 27, 29 – 34, 38, 39, 41, 42, 48, 49, 51 and 52** under 35 U.S.C. § 102(b) as being anticipated by Tsuji et al., U.S. Patent No. 5,764,898 (“Tsuji”). Claims **37 and 58**, listed in paragraph 2 as being rejected, were canceled in a previous amendment.

In paragraphs 3 and 4 of the Office Action, the Examiner has rejected claims **59 – 74, 76 – 79 and 83 – 86** under 35 U.S.C. § 102(e) as being anticipated by Barchi, U.S. Patent No. 6,507,866 (“Barchi”). Claims **75 and 90**, listed in paragraph 4 as being rejected, were canceled in a previous amendment. Applicants have canceled claims **60, 68, 77 and 84** without acquiescence to the Examiner’s reasons for rejection, and respectfully submit that rejection of those claims is thus rendered moot.

In paragraphs 5 - 8 of the Office Action, the Examiner has rejected claims **2 – 7, 20 – 25, 45 – 47, 55 – 57, 80 – 82 and 87 – 89** under 35 U.S.C. § 103(a) as being unpatentable over Tsuji and further in view of Scheier et al., U.S. Publication No. 2002/0035584 A1 (“Scheier”). Regarding dependent claims **80 – 82 and 87 – 89**, applicants believe that the Examiner intended to reject these claims as being unpatentable over Barchi in view of Scheier, instead of over Tsuji in view of Scheier,

since independent claims **76** and **83**, from which these claims respectively depend, were rejected over Barchi in paragraph 4.

In paragraph 9 of the Office Action, the Examiner has rejected claims **17, 18, 35** and **36** under 35 U.S.C. §103(a) as being unpatentable over Tsuji and further in view of Salzfass et al., U.S. Publication No. 2002/0042815 A1 ("Salzfass"). Applicants believe that Salzfass should be included in the Examiner's Notice of References Cited, form PTO-892.

In paragraphs 10 and 11 of the Office Action, the Examiner has rejected claims **10, 40, 43, 44, 50, 53** and **54** under 35 U.S.C. § 103(a) as being unpatentable over Tsuji and further in view of Barchi. Although the Examiner does not list claim **28** in paragraph 11, Applicants believe that the Examiner's intent is to also reject claim **28** over Tsuji in view of Barchi.

Response to Examiner's Arguments

Applicants have amended independent claims **1, 19, 38, 48, 59, 67, 76** and **83** to include the limitations of (i) a control mark that includes a unique identifier and an encrypted check sum for authenticating the unique identifier, and (ii) embedding the control mark within a static section of an electronic document, where the static section remains unchanged when the electronic documents is edited by a document editor. These limitations are supported in the original specification, at least at page 8, lines 8 – 20. Neither Tsuji, Barchi, Scheier, nor Salzfass, taken alone or in combination, teaches a tracking method or system for tracking as recited in the amended claims, in which a control mark is embedded that includes an encrypted check sum within a static section of the electronic document being tracked. Applicants additionally respectfully submit that the dependent claims **2-18, 20-36, 39-47, 49-57, 59, 61-66, 69-74, 78-82**, and **85-89** are allowable at least based upon their dependency from respective allowable independent claims.

For at least the foregoing reasons, Applicants respectfully submit that the applicable objections and rejections have been overcome and that the claims are in condition for allowance.

A Petition for Extension of Time (one month) is being filed concurrently herewith. The one-month extension fee is being paid via an EFT account. The Director is authorized to charge any additional fees or credit any overpayments to Deposit Account No. 50-2283 under Order No. 60644-8011.US01.

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Respectfully submitted,

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